

REMARKS

Applicant submits that the present amendment is fully responsive to the Office Action dated July 9, 2008 and, thus, the application is in condition for allowance.

By this reply, claims 1, 15, and 25 have been amended. Claim 13 remains withdrawn. Claims 1, 3-5, 8-10, 15-23, and 25 are currently pending in the application. Of these, claims 1, 15, and 25 are independent. An expedited review and allowance of the application is respectfully requested.

In the outstanding Office Action, the specification was objected to due to failure to provide antecedent basis for “computer-readable medium” as recited in claim 25. The specification has been corrected above and the claims should be allowable. No new matter has been added as such term was originally presented in the claims as filed.

In the outstanding Office Action, claims 1, 3-5, 8-10, and 15-23 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Though not necessarily agreeing with the assertions in the Office Action, for sake of expediting the prosecution of the Application, claims 1 and 15 have been amended to address the pointed concerns and should be allowable.

In the outstanding Office Action, claims 1, 3-6, 8-9, 15-22, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ostermann et al. (US 6963839) in view of Isaacs et al. (US 2004/0215728). It is asserted that Ostermann discloses substantially each element of the present invention as recited in the claims but for determining if the recipient has a file prior to sending the file. It is further asserted that Isaacs does disclose this deficiency and that the

combination of these cited references would have therefore been obvious to one having ordinary skill in the art. Applicant respectfully traverses.

With respect to independent claims 1, 15, and 25, Ostermann does not disclose or fairly suggest the present invention as recited in the pending claims. For example, Ostermann fails to teach or suggest, among other things, linking of an emoticon and a sound file wherein the linking occurs at the server according to user preferences stored on the server where the user preferences may be periodically updated by the sender, the updating occurring by obtaining different sound files from the server and replacing one or more of a set of default sound files stored in the user preferences. For instance, this is disclosed in Paragraph [0033] of the specification as published. The claimed invention provides advantages not seen in the cited references. For example, with user preferences stored on the central server and periodically updated by the user, a user can initially have a set of default audio files that can easily be linked with certain emoticons. If the user doesn't change the default settings, the defaults remain in place. By allowing the user to obtain audio files from the server and replace the defaults, the system advantageously limits the amount of network storage space required for the audio files. Ostermann discloses a text message being delivered by an animated entity (Ostermann, Column 3, Lines 13-23). Ostermann uses a text to speech system to animate a text message (Ostermann, Column 3, Lines 13-23). To the extent emoticons are used at all in Ostermann, they are used to create speech effects. Nowhere in Ostermann is there a central server which stores user preferences for linking sound files and emoticons. These preferences allow the user to choose sounds, words, phrases, etc. which will play to a recipient when the user sends an emoticon to the recipient. In Ostermann, emoticons only determine how a text message is read using the text to speech, the emoticons do not have sounds linked to them and they are certainly not able to be set by the user. These

features are simply not present in Ostermann. Ostermann does not disclose any linking of sound files already on the server with an emoticon. Ostermann does not disclose that any such linking is done according to user preferences which have been stored on the server. For instance, this feature is particularly advantageous where the end user is on a cellular telephone service. The user can store preferences to a central server and thus the user's cellular phone would not be required to upload large amounts of data to the central server. This allows the user to simply enter an emoticon into their message and the server will link a sound file based upon the user's preferences. Additionally, according to the present invention, a user may simply send emoticons without any text and when received the receiver will see the emoticons and hear the audio file associated with them as the audio file is automatically linked by the server. According to Ostermann, if simply emoticons are sent without any text, there will be no sound, as the sound is provided by the text to speech.

Furthermore, Isaacs cannot cure the deficiencies of Ostermann because Isaacs also fails to disclose at least these elements of the present claims stated above with respect to Ostermann. Isaacs is directed to a system for transmitting earcons, not emoticons (Isaacs, Paragraph [0019]). The sender selects an icon (not an emoticon) and the system transmits a corresponding sound to the recipient, not even the icon. In other words, the invention of Isaacs transmits only sound, not any corresponding text or image. For instance, Paragraph [0019] of Isaacs states that "As used herein and described in more detail later herein, the terms "sound messages", "sound instant messages" and "earcons" which are used interchangeably herein, mean a short series of notes and/or sounds which are associated with or representative of any number of short communicative phrases." Emoticons allow a user to visually represent an emotion. An emoticon is not even mentioned in Isaacs. Because an emoticon is not even mentioned, linking an emoticon and a

sound file can not possibly be disclosed. Furthermore, linking of an emoticon and a sound file wherein the linking occurs at the server according to user preferences stored on the server where the user preferences may be periodically updated by the sender, the updating occurring by obtaining different sound files from the server and replacing one or more of a set of default sound files stored in the user preferences is also not disclosed in Isaacs. Because emoticons are not mentioned in Isaacs, it is not possible for preferences to be attached to emoticons at any level. Therefore, it is clearly not possible that these preferences are stored at the server level. Thus, these preferences also cannot be updated by the user. In Isaacs, a user cannot send an emoticon to a recipient where the recipient will see an emoticon and hear a sound the user has associated with that emoticon. This feature is simply not present anywhere in Isaacs. For at least this reason, Applicant respectfully requests that this rejection be withdrawn.

Thus, neither Ostermann nor Isaacs, alone or in combination, teach all of the elements in the independent claims. Hence, the dependent claims, which depend therefrom, also are patentably distinct from any prior art of record. For this reason, Applicant respectfully requests withdrawal of the rejection. Furthermore, there is no motivation to combine any of these references outside of Applicant's own disclosure. Even if they were combinable, *arguendo*, the combination would not be able to obviate the present invention for at least the reasons set forth above. Thus, the rejection of the claims should be withdrawn.

Claims 10 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ostermann and Isaacs and in further view of Mages et al. (US 6463467). It is asserted that Ostermann and Isaacs teach all the limitations of the claims except for forwarding the emoticon and its line as a mime-encoded attachment. It is further alleged that Mages does disclose this

deficiency and the combination of these cited references would have therefore been obvious to one having ordinary skill in the art. Applicant respectfully traverses.

With respect to claims 10 and 23, neither Ostermann, Isaacs, nor Isaacs, nor any other related art of record, alone or in combination, disclose or fairly suggest the present invention as recited in the pending claims. Claims 10 and 23 are both dependent claims, dependent upon claims 1 and 15 respectively. As they are dependent claims, each element of the respective independent claim is necessarily present in them. Mages cannot cure the deficiencies of Ostermann and Isaacs with respect to the independent claims which have been stated above. Thus, the dependent claims, which depend therefrom, also contain deficiencies that Mages fails to cure. Mages is directed to a method for transmitting protected video or graphic data over the Internet from a Web site (Mages, Abs.). To the extent Mages discloses graphics or audio, it is not in the form of emoticons. Mages does not disclose any linking of sound files already on the server with an emoticon. Mages does not even disclose any linking occurring on the server. Any linking between a graphic and audio has already occurred before it reaches the server. Additionally, Mages does not disclose that any such linking is done according to user preferences which have been stored on the server. Further, the user cannot change preferences on the server to link audio files with emoticons. These features are simply not present in Mages. Therefore, Mages cannot obviate the present invention as claimed because Mages cannot cure the deficiencies of Ostermann and Isaacs. For at least this reason, Applicant respectfully request that the rejection be withdrawn. Furthermore, there is no motivation to combine any of these references outside of Applicant's own disclosure. Even if they were combinable, *arguendo*, the combination would not be able to obviate the present invention for at least the reasons set forth above. Thus, the rejection of the claims should be withdrawn.

No extension of time is believed due to enter this amendment. If any fees are associated with the entering and consideration of this amendment, please charge such fees to our Deposit Account 50-2882.

Applicant respectfully requests an interview with the Examiner to present more evidence of the unique attributes of the present invention in person. As all of the outstanding rejections have been traversed and all of the claims are believed to be in condition for allowance, Applicant respectfully requests issuance of a Notice of Allowance. If the undersigned attorney can assist in any matters regarding examination of this application, Examiner is encouraged to call at the number listed below.

Respectfully submitted,

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